

REMARKS

This paper is being submitted in response to the non-final office action dated August 29, 2006. Please enter the foregoing amendments and consider the following remarks. Withdrawal of the claim rejections is respectfully solicited based on the following grounds.

Claim 1 has been amended to recite that the cover portion is made from a flexible material. Claim 14 has been amended to correct a typographical error therein, and to provide proper antecedent basis. Claim 18 has been amended to include the recitations of claim 19. Claim 19 has been canceled. Accordingly, claims 1-18 and 20 are pending in the application.

In the action, claims 1, 4, and 6 have been rejected under 35 U.S.C. § 102(b) as anticipated by Cyr, U.S. Patent No. 6,206,567. Claims 1, 4, and 5 have been rejected as anticipated by Strong, U.S. Patent No. 5,873,730, and claims 1 and 2 have been rejected as anticipated by Everts, U.S. Patent No. 4,717,215.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as obvious over Everts, and claims 3, 7-8 and 15-20 have been rejected as obvious over Everts in view of Fox et al., U.S. Patent No. 5,779,331. In addition, claims 9-14 have been rejected as obvious over Everts in view of Fox et al., and further in view of Lodge et al., U.S. Patent No. 5,687,819.

Rejections Under 35 U.S.C. § 102 (b)

Proper Basis for a § 102(b) Rejection

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Thus, a determination that a claim is anticipated under 35 USC § 102 involves two analytical steps. First, the U.S. Patent and Trademark Office (PTO) must interpret the claim language, where

necessary, to ascertain its meaning and scope. In interpreting the claim language, the PTO is permitted to attribute to the claims only their broadest *reasonable* meaning as understood by persons having ordinary skill in the art, considered in view of the entire disclosure of the specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Second, the PTO must compare the construed claim to a single prior art reference and set forth factual findings that “each and every limitation is found either expressly or inherently [disclosed] in [that] single prior art reference.” *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998). Additionally, “[t]he identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The § 102(b) Rejections are Moot and/or Traversed

Applicants respectfully traverse the rejection of claims 1, 4, and 6 as anticipated by Cyr, the rejection of claims 1, 4, and 5 as anticipated by Strong, and the rejection of claims 1 and 2 as anticipated by Everts.

Claim 1, as amended, and claims 2 through 17, depending directly or indirectly from claim 1, are directed to a portable container for holding office products and documents. The portable container includes a rigid structural portion capable of holding hanging folders in a cascading configuration and a cover portion, made from a pliable material, attached to the rigid structural portion.

Cyr does not disclose or suggest a container that includes a rigid structural portion and a cover portion, made from a pliable material, as recited in the rejected claims. Instead, Cyr discloses a container 10 that is entirely made from a fabric material, such as “Cordura® nylon material, a cotton duck material or any suitable material that can readily be sewn for convenience in manufacturing.” Cyr at column 2, lines 59-62. Although Cyr further states at column 2, lines 62-64 that “it will be understood that other materials may be

utilized in the construction of the container 10,” there is no suggestion or disclosure that the “other materials” may be rigid, nor is there any suggestion or disclosure in Cyr that the container 10 has a rigid structural portion and a cover portion made from a pliable material (i.e., the entirety of the container 10 of Cyr is made from a single material). In addition, Cyr does not have any disclosure or suggestion of the container being capable of holding hanging folders in a cascading configuration, as also recited in the claims. It should be noted that, contrary to the reference in the office action at page 2 to “Figures 1-4 embodiments,” figures 1-4 of Cyr are all depictions of the same embodiment (i.e., a single container, rather than multiple container embodiments). See, e.g., the “BRIEF DESCRIPTION OF THE DRAWINGS” section of Cyr at column 2, lines 24-37.

With regard to the Strong patent, the same shortcomings are noted. Specifically, there is no disclosure or suggestion in Strong of a “rigid structural portion” (as alleged in the office action at page 2). Instead, the term “rigid” does not appear at all in Strong. Strong states that “Bag body 12 may be any convenient size and may be formed of any attractive, light weight material, such as leather or vinyl.” Thus, only the use of flexible materials, such as leather or vinyl, are specifically taught by Strong. Furthermore, Strong does not disclose or suggest a rigid structural portion and a cover portion made from a pliable material (i.e., the entirety of the bag body 12 of Strong is made from a single material). Furthermore, Strong fails to disclose or suggest a container that has a capability of holding hanging folders in a cascading configuration.

Everts is directed to a filing module that “includes a box of relatively rigid material” and a cover that is “hinged to the box ... and can be locked for security.” See, e.g., the Abstract section of Everts. Thus, Everts fails to disclose or suggest a cover portion made from a pliable material, as recited in the rejected claims. The Everts reference also does not

disclose or suggest holding hanging folders in a cascading configuration, but instead discloses hanging of folders from horizontal rods.

Accordingly, the rejections based on § 102(b) are improper and should be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Proper Basis for a § 103(a) Rejection

The PTO “has the burden under § 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the PTO must satisfy three basic criteria. First, the PTO must show that the combined disclosure of the prior art references teaches or suggests all of the claim limitations. *See* MPEP § 2143 (8th ed., rev. 5, Aug. 2006). Moreover, it is “incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Inter. 1990).

Second, where obviousness is alleged to arise from a combination of elements across a plurality of references, the PTO must show the existence of some suggestion, motivation, or teaching to those skilled in the art to make the precise combination recited in the claims. *See Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1320 (Fed. Cir. 2004).

Compliance with this requirement prevents the PTO’s use of “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight.”

Ecolchem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361, 1371-72 (Fed. Cir. 2000)

(quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)). Evidence of a suggestion or motivation to combine prior art references may come from “the prior art references

themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the

nature of the problem to be solved.” *Brown & Williamson Tobacco Corp. v. Philip Morris*

Inc., 229 F.3d 1120, 1125 (Fed. Cir. 2000). The PTO’s showing “must be clear and

particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not ‘evidence.’” *Id.* (quoting *In re Dembiczak*, 175 F.3d at 1000). Indeed, the U.S. Court of Appeals for the Federal Circuit has consistently held that a person having ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).

To support a conclusion that a claimed combination is *prima facie* obvious, either (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the PTO must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); *see also, In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the PTO is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). The PTO must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *Id.*; *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination.”).

Finally, the PTO must demonstrate that a person having ordinary skill in the art would have a reasonable expectation of success when combining the disclosures of the references. The suggestion or motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and must not be derived by hindsight from

knowledge of the application's disclosure. *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988); MPEP § 2143.

If an independent claim is not obvious under § 103(a), then any claim depending therefrom also is not obvious. *See* MPEP § 2143.03 (8th Ed., Rev. 5, Aug. 2006).

The § 103(a) Rejections are Moot and/or Traversed

Applicants respectfully traverse the rejection of claim 3 as obvious over Everts, and the rejection of claims 3, 7, 8, and 15-18, and 20 as obvious over Everts in view of Fox et al.

With regard to claims 3, 7, 8, and 15-17, as noted above with regard to the anticipation rejection based on Everts, Everts fails to disclose or suggest a cover portion made from a pliable material, as recited in the rejected claims. Fox et al. does not make up for the deficiencies of Everts in this regard. Thus, even if one were to combine the teachings of Everts with the teachings of Fox et al., one would not arrive at the claimed invention. Furthermore, Fox et al. does not disclose or suggest a portable container, but instead discloses a "desktop filing support." Fox et al. at column 3, line 63. Therefore, there would have been no motivation to combine the teachings of Everts with those of Fox et al. to create a portable container as claimed.

With regard to claims 18 and 20, neither Everts nor Fox et al., alone or in combination, disclose or suggest the claimed surfaces for supporting hanging file folders that are on a wire insert, as recited in claim 18, or a removable, movable adaptor that provides the capability to support one or more different sizes of hanging file folders, as recited in claim 20.

Furthermore, with regard to the statement in the office action that " Official Notice is taken that it is old and conventional to provide a removable insert for providing

hanging surfaces for hanging file folders of more than one size”, the MPEP at 2144.03(A) states:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. (Emphasis in original)

At 2144.03(B) the MPEP further states that “If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line Of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable,” and “[i]f such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” In the summary of this section, at §2144.03(E), the MPEP states,

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in Ahlert, any facts so noticed should be of notorious character and serve only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.

The applicants traverse the Official Notice regarding the removable insert, and allege that the office action has used impermissible hindsight to use Official Notice to do more than “fill in the gaps in an insubstantial manner,” but rather to take a novel feature and state in a conclusory manner that it is “old and conventional.” In fact, Everts only discloses individual modules, each of which is only capable of holding a single folder size – small (Figs. 1-4), intermediate (Fig. 5), and legal size (Figs. 6-9). Indeed, with regard to Figs. 6-9, Everts explicitly states that “The rods 22, 24 are parallel and are spaced to accommodate hanging folders 26, 28 of a specified size such as standard size or legal size.” Everts at

column 3, lines 33-36. Thus, the rods of Everts et al. can only accommodate one file size – either “standard” or “legal,” but not both at the same time. See also, column 4, lines 39-43 of Everts, which states, “Although the filing module shown in FIGS. 6-9 can accommodate two different size folders, it can accommodate only one size folder at a time, since the two different sizes are stored in perpendicular directions.” This shows that it was not recognized that it would be possible to provide a removable insert capable of supporting more than one size of folder. Thus, it is not at all “old and conventional” to provide a removable insert as claimed, or such a removable insert would be disclosed in references such as Everts.

Should the examiner persist in basing the rejection of claims 15-17 and 20 on Official Notice, Applicants respectfully request that the examiner provide some reference, or an affidavit if relying upon personal knowledge, supporting the examiner’s claim of Official Notice. MPEP 2144.03.

Applicants respectfully traverse the rejection of claims 9-14 obvious over Everts in view of Fox et al. and further in view of Lodge et al. As noted above with regard to the anticipation rejection based on Everts, Everts fails to disclose or suggest a cover portion made from a pliable material, as recited in the rejected claims. Fox et al. does not make up for the deficiencies of Everts in this regard, nor does Lodge et al. Thus, even if one were to combine the teachings of Everts with the teachings of Fox et al. and Lodge et al., one would not arrive at the claimed invention.

In connection with claim 14, the applicants traverse the Official Notice set forth at page 5 of the action, in which it is stated that “it is old and conventional to provide cushioning to storage caddies for better protecting the items held therein.” The applicants again allege that the office action has used impermissible hindsight to use Official Notice to do more than “fill in the gaps in an insubstantial manner,” but rather to take a novel feature and state in a conclusory manner that it is “old and conventional.” In this regard, it is also

important to note that claim 14, as amended, recites that the “storage caddy has a lower portion that provides a cushion at the bottom of the rigid structural portion.” Thus, the allegation in the office action that it is “old and conventional to provide cushioning to storage caddies for better protecting the items held therein,” is not relevant to what is actually recited in claim 14, since claim 14 is not reciting anything about providing cushioning for items held within the storage caddy, but rather is for providing a cushion at the bottom of the rigid structural portion. Support for this claimed feature may be found, for example, in the fourth paragraph of page 4 of the specification, and in FIGS. 4, 5, and 7 of the application.

Should the examiner persist in basing the rejection of claim 14 on Official Notice, Applicants respectfully request that the examiner provide some reference, or an affidavit if relying upon personal knowledge, supporting the examiner’s claim of Official Notice. MPEP 2144.03.

Prima facie obviousness under § 103 is a legal conclusion — not a fact. *In re Rinehart*, 531 F.2d at 1052. The foregoing response identifies facts (e.g., evidence in the form of statements in the prior art) rebutting the alleged legal conclusion that the claimed invention is *prima facie* obvious. All of these facts must be evaluated along with the facts on which the legal conclusion was originally reached — not the legal conclusion itself. Having requested herein reconsideration of the legal conclusion set forth in the official action, the PTO is obligated to address all of the evidence and base its forthcoming legal conclusion(s) on such evidence, uninfluenced by its earlier conclusions. *Id.*

Given these shortcomings, it is respectfully submitted that the claimed invention is unobvious. Accordingly, reconsideration and withdrawal of the obviousness rejections are requested.

CONCLUSION

It is submitted that claims 1-18 and 20 are now in proper form and scope for allowance. Early and favorable consideration is respectfully requested.

In view of the foregoing, the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,

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